REMARKS

Claims 29-31, 36 and 37 are pending in the application. Claims 1, 2, 4-8, and 10 were withdrawn from consideration by the Examiner. Claims 29-31, 36 and 37 are rejected. Claim 30 is herein amended. Applicant requests reconsideration of the rejections in light of the following remarks and hereby requests further examination of the present application.

Applicant traverses the withdrawal from consideration of claims 1, 2, 4-8 and 10 and requests reconsideration of the withdrawal from consideration of the aforementioned claims. A summary of the interview with the Examiner and his SPE are summarized below.

<u>Interview Summary</u>

On August 4, 2008 at 2:00 pm, Carmen Lyles-Irving and William F. Smith of Woodcock Washburn LLP (hereinafter "Applicant's representatives") held an interview with Examiner Allen Nguyen and SPE King Poon. During the interview, Applicant's representatives presented arguments that withdrawing claims 1, 2, 4-8 and 10 from consideration is improper because amended claim 1 is now a linking claim. To explain, claim 3, drawn to the elected species, was canceled. In turn, claim 1 was amended to include all of the claim elements of originally filed claim 3. As a result, amended claim 1 and its dependent claims now contain the claim features of originally filed claim 3. Accordingly, Applicants now believe that amended claim 1, which now incorporates the features of claim 3, drawn to the elected species, should not be withdrawn. The MPEP does not prevent the Applicant from amending claim 1 in such a way.

Applicants and Applicant's representatives believe that there is no undue burden on the Examiner by requiring the Examiner to perform a new search on claim 1 as amended because every time a claim is amended the Examiner is required to perform at least an updated search on the amended subject matter. Additionally, if the Applicant amends the claims to bring in information from the specification that has not previously been searched, the Examiner will be required to perform a new search at that time.

During the interview, the Applicant's representatives also presented arguments against the use of <u>Barry et al</u>. (U.S. 5,859,711) as §102(b) prior art against claims 29-31, 36 and 37 (discussed below).

No agreement was reached during the interview regarding the withdrawal from consideration of claims 1, 2, 4-8 and 10 *or* regarding <u>Barry et al.</u> as failing to inherently or expressly teach the claim limitations of claims 29-31, 36 and 37.

Claim Amendment

Claim 30 is herein amended to clarify that each claim element presented is an individual step of the computer-implemented method for printing a plurality of digital images. No new matter has been added by way of the amendment.

Summary of the Rejections

- Claims 29-31, 36-37 were rejected under 35 U.S.C. §102(b) as being anticipated by <u>Barry et al</u>. (U.S. 5,859,711).

Claim Rejections under 35 U.S.C. §102(b)

Claims 29-31, 36-37 are rejected under are 35 U.S.C. §102(b) as being allegedly anticipated by <u>Barry et al</u>. Applicant traverses the rejections and requests reconsideration thereof.

Claims 36 and 37

Claim 36 is drawn to a system for printing a plurality of digital images. Regarding claim 36, the Office states that <u>Barry et al.</u> discloses a print engine activation means for activating a print engine to print the first plurality of processed images. The Applicant notes, however, that the print engine activation means of the instant invention is representative or exemplary of the start print command 30 illustrated in FIG. 1. The specification discloses:

> Once the first set of processed images 128a is stored in the RAMdisk 134, the image processing unit 126 (or other component within the client 114) transmits a start print command 130 to the print server 116 over communications bus 132 (step 312). The start print command 130 is received by print controller 136 in the print server 116. In response to receiving the

start print command 130, the print controller 136 begins transmitting
processed image files from the RAMdisk 134 to a print engine 140 in the print
server 116 (step 314). As a result the print engine 140 prints the first set of
processed images 128a in the order in which they were transmitted and stored
in the RAMdisk 134 (step 316). *Specification*, page 18, lines 6-19.

The Applicant further notes that the Job Manager 360 in Figure 12 of Barry et al. fails

to indicate a print engine activation means for activating a print engine to print the first

plurality of processed images. The Job Manager instead

will essentially perform the operation of the parsing and will ensure that pages
that are extracted from the internal page buffer (not shown) will be routed to
the appropriate engine in the appropriate manner and at the appropriate time.
Specification, column 15, lines 3-8.

During the August 4, 2008 interview with Examiner Nguyen and SPE Poon, it was

alleged that is inherent that the Job Manager of Barry et al. would activate the print engine.

Applicants note, however, that "[i]nherency...may not be established by probabilities or

possibilities. The mere fact that a certain thing may result from a given set of circumstances

is not sufficient." *In re Robertson*, 49 USPQ2d 1949, 1951 (Fed. Cir. 1999). Accordingly, as

claim 36 fails to expressly or inherently disclose the claim element "a print engine activation

means for activating a print engine to print the first plurality of processed images," the

anticipation rejection of claim 36 is improper.

Claim 37 depends from claim 36 and adds further elements thereto. Applicant

submits that for at least the reasons stated above with respect to the patentability of claim 36,

Barry et al. fails to anticipate at least the claim element a print engine activation means for

activating a print engine to print the first plurality of processed images. Therefore, the

Applicant requests the rejection under 35 U.S.C. §102(b) be withdrawn and solicits

allowance of claim 37.

In view of the foregoing arguments, Applicant submits that the Office has failed to

establish a proper Section 102 rejection, and therefore, requests the Office to withdraw the

rejections of claims 36 and 37 under 35 U.S.C. §102(b) as being anticipated by Barry et al.

Claims 29-30

The Examiner in the Office Action states that claims 29-30, the method claims of devices claims 36-37, are rejected for the reasons given in device claims 36-37. Regarding claim 29, the Applicant again notes as indicated regarding claim 36 that Barry et al. fails to indicate a print engine activation means as indicated by the Examiner as Job Manager 360 in Figure 12. The Job Manager of Barry et al. instead

> will essentially perform the operation of the parsing and will ensure that pages that are extracted from the internal page buffer (not shown) will be routed to the appropriate engine in the appropriate manner and at the appropriate time. *Specification*, column 15, lines 3-8.

Regarding claim 30, claim 30 depends from claim 29 and adds further elements thereto. Applicant submits that for at least the reasons stated above with respect to patentability of claim 29, Barry et al. fails to anticipate at least the claim element a print engine activation means for activating a print engine to print the first plurality of processed images. Therefore, the Applicant requests the rejection under 35 U.S.C. §102(b) be withdrawn and solicits allowance of claim 30.

In view of the foregoing arguments, Applicant submits that the Office has failed to establish a proper Section 102 rejection, and therefore, requests the Office to withdraw the rejections of claims 29 and 30 under 35 U.S.C. §102(b) as being anticipated by Barry et al.

Claim 31

Claim 31 depends from claim 29 and adds further elements thereto. Applicant submits that for at least the reasons stated above with respect to patentability of claim 29, Barry et al. fails to anticipate at least the claim element a print engine activation means for activating a print engine to print the first plurality of processed images. Therefore, the Applicant requests the rejection under 35 U.S.C. §102(b) be withdrawn and solicits allowance of claim 31.

CONCLUSION

In view of the foregoing remarks, Applicant respectfully submits that claims 1, 2, 4-8, and 10 should be examined in the next Office Action and that claims 29-31, 36 and 37 are in condition for allowance and notification to that effect is earnestly requested. If necessary, the Examiner is invited to telephone Applicant's attorney at the number provided below to facilitate prosecution of the application.

The Commissioner is hereby authorized to charge any deficiency or credit any overpayment of fees associated with this communication to Deposit Account No. 23-3050.

The Commissioner is hereby requested to grant an extension of time for the appropriate length of time, should one be necessary, in connection with this filing or any future filing submitted to the U.S. Patent and Trademark Office in the above-identified application during the pendency of this application. The Commission is further authorized to charge any fees relating to any such extension of time to Deposit Account 23-3050.

Date: November 18, 2008   /Carmen V. Lyles-Irving/

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